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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91252817
Party	Plaintiff House of Kuipers, LLC
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Date	05/22/2020
Attachments	Answer and Affirmative Defenses to Counterclaims - FINAL.pdf(149381 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF TRADEMARK SERIAL NO. 88/228,839

House of Kuipers LLC, a California limited liability company, et al.,)	
)	
)	
Opposer,)	
)	
v.)	
)	
John Zox, an Individual,)	
)	
Applicant.)	
)	

Opposition No.: 91252817

ANSWER TO COUNTERCLAIMS OF APPLICANT

Opposer and Counter-Defendant House of Kuipers (“Opposer”), hereby responds to Applicant and Counterclaimant John Zox (“Applicant”) as follows:

FACTS

Background on Applicant and Applicant’s ZOX Marks

1. Opposer admits that Applicant purports to be a member of a band purportedly called Zox. Otherwise, Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 1 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

2. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 2 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

3. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 3 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

4. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 4 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

5. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 5 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

6. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 6 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

7. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 7 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

8. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 8 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

9. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 9 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

10. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 10 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

11. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 11 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

12. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 12 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

13. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 13 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

Opposer's Unlawful Conduct

14. Opposer denies each and every allegation of paragraph 14 of the Counterclaims.

15. Opposer admits that it owns trademark registrations for ZOX, ZOX STRAPS and ZOXBOX. Otherwise, Opposer presently lacks sufficient information to admit or deny any of the

allegations or statements in paragraph 15 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

16. Opposer admits the allegations of paragraph 16 of the Counterclaims.

17. In response to paragraph 17 of the Counterclaims, Opposer denies that it needs any permission from Applicant to use Opposer's ZOX, ZOX STRAPS and ZOXBOX marks.

18. Opposer admits that it claims to have conceived the mark ZOXSTRAPS in 2011. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 18 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

19. Opposer denies each and every allegation of paragraph 19 of the Counterclaims.

20. Opposer admits that it has filed trademark registrations for ZOX and like marks. Otherwise, Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 20 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

21. Opposer denies that it needs any permission from Applicant to use its (Opposer's) ZOX marks. Otherwise, Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 21 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

22. In response to paragraph 22 of the Counterclaims, Opposer admits that on or about September of 2016, Opposer had a telephone conversation with Applicant. Opposer denies

admitting to actual confusion.

23. Opposer denies each and every allegation of paragraph 23 of the Counterclaims.

24. Opposer denies each and every allegation of paragraph 24 of the Counterclaims.

25. Paragraph 25 of the Counterclaims state a legal conclusion to which no response is required. To the extent paragraph 25 contains any factual allegations, such allegations are denied.

26. Opposer admits that it sells a product under the name “Starry Night.” Otherwise, Opposer denies each and every allegation of paragraph 26 of the Counterclaims.

PRIORITY/LIKLIHOOD OF CONFUSION

27. In response to paragraph 27 of the Counterclaims, Opposer states that the allegations of paragraph 21 of the Notice of Opposition speak for themselves.

28. In response to paragraph 28 of the Counterclaims Opposer admits that it owns federal trademark registrations for ZOX, ZOX STRAPS and ZOXBOX.

29. In response to paragraph 29 of the Counterclaims, Opposer states that the allegations of paragraph 16-19 of the Notice of Opposition speak for themselves.

30. In response to paragraph 30 of the Counterclaims, Opposer admits that it owns U.S. Trademark Registration No. 4,759,961 for ZOXBOX for the categories of goods and services stated in the registration.

31. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 31 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

32. Opposer denies that any grounds exist for the cancellation of Opposer's U.S. Trademark Registration No. 4,759,961 for ZOXBOS.

33. In response to paragraph 33 of the Counterclaims, Opposer states that the allegations of paragraph 16-19 of the Notice of Opposition speak for themselves.

34. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 34 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

35. Opposer denies that any grounds exist for the cancellation of Opposer's U.S. Trademark Registration No. 5,233,845 for ZOXBOS.

NON-USE

36. Opposer denies each and every allegation of paragraph 36 of the Counterclaims.

37. Opposer denies each and every allegation of paragraph 37 of the Counterclaims.

38. Opposer denies each and every allegation of paragraph 38 of the Counterclaims.

39. Opposer denies each and every allegation of paragraph 39 of the Counterclaims.

40. Opposer denies each and every allegation of paragraph 40 of the Counterclaims.

41. Opposer denies each and every allegation of paragraph 41 of the Counterclaims.

42. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 42 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

43. Opposer presently lacks sufficient information to admit or deny any of the allegations or statements in paragraph 43 of the Counterclaims and, therefore, on that basis generally and specifically denies the same.

44. Opposer denies the allegations of paragraph 44 of the Counterclaims.

45. Opposer denies the allegations of paragraph 45 of the Counterclaims.

46. Opposer denies the allegations of paragraph 46 of the Counterclaims.

47. In response to paragraph 47 of the Counterclaims, Opposer admits that on or about May of 2013, Opposer filed Application Serial No. 85948145 to register the ZOX on the principle register. Opposer admits that its then attorney of record filed a declaration of use in support of the registration. Opposer admits that the mark was first used in commerce at least as early as the date stated in the declaration.

48. Opposer denies the allegations of paragraph 48 of the Counterclaims.

49. Opposer denies the allegations of paragraph 49 of the Counterclaims.

50. Opposer denies the allegations of paragraph 50 of the Counterclaims.
51. Opposer denies the allegations of paragraph 51 of the Counterclaims.
52. Opposer denies the allegations of paragraph 52 of the Counterclaims.
53. Opposer denies the allegations of paragraph 53 of the Counterclaims.
54. Opposer denies the allegations of paragraph 54 of the Counterclaims.
55. Opposer denies the allegations of paragraph 55 of the Counterclaims.
56. Opposer denies the allegations of paragraph 56 of the Counterclaims.
57. Opposer denies the allegations of paragraph 57 of the Counterclaims.
58. Opposer denies the allegations of paragraph 58 of the Counterclaims.
59. Opposer denies the allegations of paragraph 59 of the Counterclaims.
60. Opposer denies the allegations of paragraph 60 of the Counterclaims.
61. Opposer denies the allegations of paragraph 61 of the Counterclaims.
62. Opposer denies the allegations of paragraph 62 of the Counterclaims.
63. Opposer denies the allegations of paragraph 63 of the Counterclaims.

- 64. Opposer denies the allegations of paragraph 64 of the Counterclaims.
- 65. Opposer denies the allegations of paragraph 65 of the Counterclaims.
- 66. Opposer denies the allegations of paragraph 66 of the Counterclaims.
- 67. Opposer denies the allegations of paragraph 67 of the Counterclaims.
- 68. Opposer denies the allegations of paragraph 68 of the Counterclaims.
- 69. Opposer denies the allegations of paragraph 69 of the Counterclaims.
- 70. Opposer denies the allegations of paragraph 70 of the Counterclaims.
- 71. Opposer denies the allegations of paragraph 71 of the Counterclaims.
- 72. Opposer denies the allegations of paragraph 72 of the Counterclaims.
- 73. Opposer denies the allegations of paragraph 73 of the Counterclaims.
- 74. Opposer denies the allegations of paragraph 74 of the Counterclaims.
- 75. Opposer denies the allegations of paragraph 75 of the Counterclaims.

76. Opposer denies the allegations of paragraph 76 of the Counterclaims.
77. Opposer denies the allegations of paragraph 77 of the Counterclaims.
78. Opposer denies the allegations of paragraph 78 of the Counterclaims.
79. Opposer denies the allegations of paragraph 79 of the Counterclaims.
80. Opposer denies the allegations of paragraph 80 of the Counterclaims.
81. Opposer denies the allegations of paragraph 81 of the Counterclaims.

PRAYER FOR RELIEF

Opposer denies that Registrations Nos. 4,465,691 for ZOX, 4,759,961 for ZOXBOX, and Registration No. 5,233,845 for ZOX should be cancelled either in whole or in part.

AFFIRMATIVE DEFENSES TO COUNTERCLAIMS

Opposer asserts that the following defenses are at issue or will be at issue after an opportunity to conduct discovery:

First Affirmative Defense – Priority

1. Applicant's counterclaims are barred because Opposer has priority of use of the mark over Applicant as to the goods and market at issue. As the assignee of Zox International, Inc., Opposer is the owner by assignment of the goodwill in the mark ZOX (i.e. Reg. No. 2992108 for which a Section 8 declaration was filed and accepted by the Trademark Office),

where the assigned mark was first used in commerce at least as early as 1992 or well before any date of first use claimed by Applicant. Zox International, Inc. used the mark ZOX as an identifier for a variety of goods and services, including clothing and accessories; namely, jackets, coats, sweaters, pants, shirts, shorts, swimwear, and undergarments for women and men, jogging suits, T-shirts, tank tops, jerseys, cotton woven shirts, knit shirts, polo shirts, golf shirts, dresses, blouses, nightgowns, pajamas, sweat pants, sweatshirts, jogging suits, neckties, belts, suspenders, sandals, shoes, caps, hats, wristbands, head bands, sun visors, scarves, bandannas, ear muffs, gloves, mittens, leg warmers, pantyhose, stockings, leotards, tights, and leggings in International Class 25, or upon substantially the same goods and services as sold by Opposer today.

Second Affirmative Defense – Abandonment

2. Applicant abandoned his rights in his asserted mark through non-use, ornamental use, or by acts that caused the mark to lose its significance as an indication of origin. Upon information and belief, Applicant made no use of the ZOX mark in commerce on some or all of the goods and services listed on Application Serial No. 88/28,839 for at least three years between 2014 and 2020 and likely for all such years.

Third Affirmative Defense - Intervening Rights

3. Applicant's claims are barred because Applicant's mark is unenforceable against Opposer due to Applicant's failure to use the mark in commerce for one or more years. Upon information and belief, Applicant made no use of the ZOX mark in commerce on some or all of the goods and services listed on Application Serial No. 88/28,839 for at least one year between 2014 and 2020 and likely for all such years.

Fourth Affirmative Defense – Estoppel

4. Applicant's claim is barred by reason of Applicant's own conduct, express statements and admissions and, as a result thereof, Applicant is estopped from asserting any wrongful act or improper conduct on the part of Opposer. Applicant has had actual knowledge of Opposer's ZOX marks for at least six years, yet Applicant sent no cease and desist letters and has otherwise taken no action against Opposer for any alleged improper use of the mark ZOX during this period.

Fifth Affirmative Defense – Acquiescence

5. Applicant's claim is barred in whole or part because Applicant has acquiesced to Opposer's use of the mark. Applicant has had actual knowledge of Opposer's ZOX marks for at least six years, yet Applicant sent no cease and desist letters and has otherwise taken no action against Opposer for any alleged improper use of the mark ZOX during this period.

Sixth Affirmative Defense – Laches

6. Applicant's claim is barred by Applicant's unreasonable delay in asserting and/or pursuing its purported legal rights or remedies against Opposer to the substantial and continuing prejudice of Opposer and, as a result thereof, Applicant is precluded from belatedly asserting such claims against Opposer by the equitable doctrine of laches. Applicant has had actual knowledge of Opposer's ZOX marks for at least six years, yet Applicant sent no cease and desist letters and has otherwise taken no action against Opposer for any alleged improper use of the mark ZOX during this period.

Seventh Affirmative Defense - (Waiver)

9. Applicant's claim is barred as a result of Applicant's own conduct, affirmative statements and admissions, as well as a result of Applicant's failure to timely assert any objection to the alleged use of the mark by Opposer. Consequently, Applicant has waived any cause of

action and/or claim for relief in conjunction therewith, and thus is barred or precluded from maintaining such action or obtaining any judgment or relief whatsoever against Opposer.

Applicant has had actual knowledge of Opposer's ZOX marks for at least six years, yet Applicant sent no cease and desist letters and has otherwise taken no action against Opposer for any alleged improper use of the mark ZOX during this period.

Respectfully submitted,

CISLO & THOMAS LLP

Dated: May 22, 2020

/Daniel M. Cislo/

Daniel M. Cislo, Esq.

David B. Sandelands, Esq.

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing ANSWER TO COUNTERCLAIMS OF APPLICANT was served upon the attorney for John Zox, by electronic mail only, to DARREN GELIEBTER, deliebter@lgrademarklaw.com, on the date given below.

Dated: May 22, 2020

/Daniel M. Cislo/

Daniel M. Cislo, Esq.

David B. Sandelands, Esq.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on the date shown below.

Dated: May 22, 2020

/Daniel M. Cislo/

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